

Claim Rejections - 35 USC §103

In the Office Action, the Examiner rejects Claims 1-5 and 7-14 under 35 USC §103(a) as being unpatentable over Shimada (US 6,323,051) in view of Suzawa et al. (US 7,071,037). This rejection is respectfully traversed.

Applicants respectfully submit that this rejection is improper under 35 USC §103(c). In particular, 103(c)(1) states:

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (f) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

In this case, the present application was filed on April 19, 2006 (as the national stage of a PCT application). While Suzawa was filed on March 4, 2002, it did not issue as a patent until July 4, 2006. Hence, the Examiner must be citing Suzawa as a §102(e) reference. Further, both Suzawa and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person (i.e. Semiconductor Energy Laboratory Co., Ltd.).

Therefore, since Suzawa is viewed as subject matter developed by another person (i.e. H. Suzawa, Y. Kusuyama and S. Yamazaki for Suzawa; Y. Higaki, M. Sakakura and S. Yamazaki for the present application) which qualifies as prior art only under §102(e) and the subject matter of Suzawa and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, Suzawa shall not preclude patentability under §103.

Accordingly, it is respectfully requested that this rejection be withdrawn.

Conclusion

It is respectfully submitted that the present application is in a condition for allowance and should be allowed.

If any fee should be due for this response, please charge our deposit account 50/1039.

Favorable reconsideration is earnestly solicited.

Date: September 15, 2009

Respectfully submitted,

/Mark J. Murphy/
Mark J. Murphy
Registration No. 34,225

COOK ALEX LTD.
200 West Adams Street, Suite 2850
Chicago, Illinois 60606
(312) 236-8500

Customer No. 26568